

REMARKS

The above amendments are made in response to the Office Action of December 29, 2006, and they are consistent with the discussion with SPE Carl Friedman on January 31, 2007.

The courtesy and assistance offered the undersigned attorney, Warren Sklar, in the telephone interviews by Mr. Friedman are noted with appreciation. During the telephone interviews a number of the points previously raised distinguishing the claims over the applied Niederost (4074341) reference were discussed with Mr. Friedman. The newly cited Nakamura (JP 02002091691A) reference also was discussed. Nakamura concerns a rocker switch for a pointing device wherein the proximity of a magnet to switches determines which switch responds to the magnet. The magnet is not used to mount a cover to a base.

The application includes claims 6-21, 68, 71-76, 85, 86, and 92-94.

Claims 6-21 and 68 were indicated allowable by Mr. Friedman, subject to amending the word "mount" to read –support– (and associated change of the word "to" to read –from–), as has been done above. It is noted that the word "support" originally was in the claims; it was changed to "mount" due to comments made by the examiners during a personal interview with them, as was discussed in a prior Amendment.

Claims 71-76 have been amended to depend directly or indirectly from claim 68 and, therefore, also should be allowable. Claims 71-76 point out that a smoke detector or light fixture is attached to the mounting member. Claims 71-76 depend directly or indirectly from allowable claim 68; they previously depended from canceled claim 70.

Mr. Friedman and the undersigned briefly discussed the method claims 85-88. Mr. Friedman indicated that he did not focus on the method claims and that he was not prepared at the time to commit to an opinion of allowance or not of those method claims. He did suggest amending the method claims to include carrying out the method using apparatus employing a dual retention mechanism. Claims 85 and 86 have been amended accordingly. New claims 92-94 have been added to point out a method that uses a fixture mounting structure generally along the lines of allowable claim 19. The

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method steps expressed in the method claims are not disclosed or suggested in the applied references.

Withdrawal of the rejection of claims 19-21, 27 and 85-88 under 35 U.S.C. 102(b) in view of Niederost 4074341 is respectfully requested for the reasons already of record. Additionally, with regard to the rejection of claims 85-88 and the allegation, "the method is inherent to the structural limitation set forth in the claims," withdrawal of such inherency rejection is respectfully requested.

The Examiner has failed to meet the burden imposed by MPEP §2112 for a rejection based on inherency. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic." MPEP §2112 IV citing *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). MPEP §2112 IV continues with the following instructions.

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

"In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

It is respectfully submitted that Niederost is not understood to inherently disclose or suggest the claimed invention. Further, it is respectfully submitted that the Examiner has not met the burden imposed by MPEP §2112 for a rejection based on inherency.

Withdrawal of the rejection of claims 17-18 under 35 U.S.C. 103(a) as being unpatentable over Nakamura '91 is respectfully requested. Nakamura concerns a rocker switch for a pointing device wherein the proximity of a magnet to switches determines which switch responds to the magnet. The magnet is not used to mount a

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cover to a base. Further, Nakamura does not concern a light fixture or smoke detector. Accordingly, it is submitted that the Examiner has not made a *prima facie* case of obviousness.

The allowance of claims 6-12 and 68 is noted with appreciation. In view of the above it is believed that all claims are allowable.

Accordingly this application is believed to be in condition for allowance, and an early action to that end earnestly is solicited.

If there are any questions, the Examiner is urged to telephone or to email the undersigned.

As the application originally was filed with 66 total claims including 16 independent claims and the application now includes 29 total claims including 12 independent claims, it is believed that no fee is required for this filing. However, if there is a fee needed, please charge the fee to applicant's attorneys' deposit account 18-0988 (under the above docket number).

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

/Warren A Sklar/
Warren A. Sklar
Reg. No. 26,373

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The Keith Building
1621 Euclid Avenue
Nineteenth Floor
Cleveland, Ohio 44115
(216) 621-1113

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 X being transmitted via EFS or via facsimile to (571) 273-8300 (Centralized Facsimile Number) at the U.S. Patent and Trademark Office to the Attention of Examiner Todd M. Epps.

/Warren A Sklar/
Warren A. Sklar

March 29, 2007
Date